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10/579,803

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Shinji Inoue

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SMITH PATENT OFFICE

1901 PENNSYLVANIA AVENUE N W

SUITE 901

WASHINGTON, DC 20006

EXAMINER

SORRELL, IRON J

ART UNIT

PAPER NUMBER

2182

MAIL DATE

DELIVERY MODE

07/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,803

Applicant(s)

INOUE ET AL.

Examiner

ERON J. SORRELL

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-13, 15-20, 24-26 and 28 is/are rejected.
- 7) ☒ Claim(s) 6, 9, 21 and 23 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/003)
Paper No(s)/Mail Date 20060518
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Referring to claim 10 recites the limitation, "said card controller gives priority to setting of the switching part **close to** either of said recording medium or said information processing device (emphasis added)." This limitation is unclear to the Examiner. The term "close to" is relative language. It is unclear how many adapters away from either the medium or information processing device would be considered close.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5,8,11-13,15-20,24-26, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Minami et al. (U.S. Pub. No. 2003/0163620 hereinafter "Minami").

6. Referring to claims 1 and 16, Minami teaches a recording medium access device (see item 10 in figure 2) for accessing a recording medium having a plurality of functions (see item 14 in figure 2, note the memory can perform at least reading and writing) comprising:

a switching part that can be operated from the outside (see item 42 and 42a in figure 2); and

a card controller (see item 54 in figure 2) for issuing a switching command to switch an operation of said recording medium access device to the attached recording medium according to an operation to said switching part (see paragraph 42).

7. Referring to claims 2 and 17, Minami teaches the switching part is a switch part for holding the switched state (see paragraph 12).

8. Referring to claims 3 and 18, Minami teaches a determination part for detecting a state of said switching part at initialization of said recording medium or said recording medium access device and determining whether or not an operation to said recording medium is switched, wherein said card controller issues the switching command to said recording medium according to a determination result of said determination part (see paragraph 42).

9. Referring to claims 4 and 19, Minami teaches the switching part is a switch part for inputting switching (see item 42a in figure 2).

10. Referring to claims 5 and 20, Minami teaches said recording medium access device is an adapter (see item 10 in figure 2) attached to an information processing device (see item 12 in figure 2) for relaying a signal between said information processing device and said recording medium (see item 14 in figure 2) (see also paragraph 12).

11. Referring to claim 8, Minami teaches the switching part has a plurality of switching states (see item 42a in figure 3, note the two states).

12. Referring to claims 11 and 24, Minami teaches a notification determination part for determining whether or not to inform to said information processing device that an operation of said recording medium has been switched, wherein when determination is made that notification is required by said notification determination part, said card controller informs that the operation of said recording medium has been switched to said information processing device (see paragraph 42).

13. Referring to claims 12 and 25, Minami teaches notification determination part judges necessity of notification on the basis of setting of said information processing device (see paragraph 42).

14. Referring to claims 13 and 26, Minami teaches an area information storage part for storing operation state of said recording medium therein, wherein when said switching part is operated, said card controller compares area information stored

in said area information storage part and issues a switching command to said recording medium if a change has been occurred (see item 38 in figure 2 and paragraph 41).

15. Referring to claims 15 and 28, Minami teaches a state information storage part for storing state information of said information recording medium therein, wherein when said switching part is operated, said card controller compares state stored in said state information storage part and issues a switching command to said recording medium if the change has been occurred (see item 38 in figure 2 and paragraph 41).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claims 14 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami in view of Okamoto (U.S. Patent No. 6,993,690).

18. Referring to claims 14 and 27, Minami teaches the device and method of claims 1 and 16, as shown above, Minami further teaches a state information storage part for holding state information of said recording medium (see item 38 in figure 2 and paragraph 41), however fails to teach a display part for displaying an operation state of said information recording medium.

Okamoto teaches, in an analogous system, a display part for displaying an operation state of said information recording medium (see item 14 in figure 1 and lines 36-50 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the teachings of Minami with the above teachings of Okamoto in order to provide the user with useful feedback concerning the status of the storage device as suggested by Okamoto (see abstract).

19. Claims 7 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Minami in view of Nakai et al. (U.S. Pub. No. 2006/0069925 hereinafter "Nakai").

20. Referring to claim 7 and 22, Minami teaches the device and method of claims 5 and 20, as shown above, however, Minami fails to teach the recording medium has an authentication area requiring mutual authentication with an information processing device, and said card controller issues a switching command after completion of the mutual authentication.

Nakai teaches, in an analogous system, the recording medium has an authentication area requiring mutual authentication with an information processing device, and said card controller issues a switching command after completion of the mutual authentication (see paragraph 90).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the teachings of Nakai in order to provide a security mechanism to the user for the protection of sensitive data.

Allowable Subject Matter

21. Claims 6,9,21, and 23, objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

22. Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERON J. SORRELL whose telephone number is (571)272-4160. The examiner can normally be reached on Monday-Friday 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eron J Sorrell/
Primary Examiner, Art Unit 2182
July 10, 2009